

REMARKS

Applicants thank the Examiner for the courtesy extended to Applicants' attorney during the interview held May 12, 2004, in the above-identified application. During the interview, Applicants' attorney explained the presently-claimed invention and why it is patentable over the applied prior art, and discussed other issues raised in the Office action. The discussion is summarized and expanded upon below.

The presently claimed optical recording medium provides a way by which manufacturers of optical recording media can imprint or mark their product with, for example, a trademark, trade name or other trade dress in a manner that does not interfere with the later placement of a printed layer on the trademark, trade name or trade dress.

Conventional optical recording media may be marked (e.g., may have a pattern placed thereon) by, for example, conventional printing techniques such as ink-jet printing. While this is an effective means for marking the optical recording medium with the manufacturer's trade information, it may substantially interfere with the later placement of a second printed layer on top of the manufacturer's printed trade information. This problem may arise because the printed layers may inter-diffuse or dissolve in one another thereby providing a pattern that has a smeared appearance. The claimed optical recording medium provides an optical recording medium that allows marking with a pattern (which may include trade or marketing information) in a manner that does not interfere with the later printing of a second pattern thereon.

In other than new Claim 34, Applicants have claimed an optical recording medium having a print-receiving layer bearing a pattern visible to the naked eye wherein both the print-receiving layer and the pattern comprise a cation resin. The pattern may be a pattern of concaves and/or convexes present on/in the surface of the print-receiving layer or areas of different color on/in the print-receiving layer (the pattern may be both on and in the print-

receiving layer). Regardless of the manner in which the pattern manifests itself on/in the print-receiving layer, the claimed optical recording medium having a pattern is still in a virgin printing condition and thereby allows any later printing operation to provide a high quality pattern (e.g., image).

The rejections of Claims 1-4, 17, 26-28, 30 and 32-33 under 35 U.S.C. § 102(b) as anticipated by, and of Claims 29 and 31 as unpatentable over, JP 2000-57635 (Fujio et al), are respectfully traversed.

Fujio et al, which is earlier work of the present assignee, is drawn to:

An optical recording medium suitable for printing characteristics of a full-color liquid ink jet printer by forming a print accepting layer on an outermost layer from a UV setting resin composition containing a cation resin and fine particles in a specified range of the particle size (see English abstract).

Fujio et al does not disclose an optical recording medium having a pattern wherein the pattern comprises a cation resin. Indeed, Fujio et al does not disclose or suggest a pattern *per se* as that term is used herein at all.

Fujio et al discloses at paragraph [0014] that "[a] fundamentally different point of the printing acceptance layer in the optical recording medium of this invention and the conventional printing acceptance layer is the ink absorption mechanism of an ink jet printer." Thus, Fujio et al is drawn to media formed from resins that allow good ink absorption. Fujio et al does not contemplate the presence of a pattern on the print-receiving layer in the manner presently claimed. Therefore, while Fujio et al may disclose an optical recording medium that is suitable for printing a pattern thereon, Fujio et al does not disclose an optical recording medium wherein a pattern present on/in the print-receiving layer is itself a suitable print-receiving layer.

As Applicants' attorney explained during the above-referenced interview, the printing relied on by the Examiner, and the printing described by Fujio et al, relates to printing on the

print accepting layer (analogous to the presently-recited print-receiving layer) of Fujio et al, not the formation of a pattern on, in or as at least part of the print accepting layer prior to printing thereon. A major distinction between the presently-claimed invention and Fujio et al is that in the present invention, a pattern is previously formed on an ink-receiving layer prior to subjecting the print-receiving layer to printing, while Fujio et al discloses the formation of no such pattern. In addition, the present claims now explicitly require that the pattern is capable of being printed thereon when print is applied to the print-receiving layer, a concept neither disclosed nor suggested by Fujio et al.

Nor does Fujio et al, or any of the previously-applied prior art, disclose or suggest the subject matter of new Claim 34, for reasons discussed above.

For all the above reasons, it is respectfully requested that the rejections be withdrawn.

The objection to the drawings is respectfully traversed. A proposed new drawing (Figure 3) is submitted concurrently herewith responsive to the Office Action of April 21, 2004. Note that Figure 3 is exemplary only, since there is no limit to the potential number of pattern of colors. Accordingly, it is respectfully requested that the objection be withdrawn.

The rejection of Claims 2 and 30-33 under 35 U.S.C. § 112, second paragraph, is respectfully traversed. With regard to part (a) of the rejection, it is now moot in view of the cancellation of Claim 2. With regard to part (b), it is now moot in view of the amendment of Claim 30 into independent form, so that there is now no possible indefiniteness with regard to the "print-receiving layer" and the "pattern". With regard to (c), it is also now moot in view of the above-discussed amendment. Accordingly, it is respectfully requested that this rejection be withdrawn.

The objection to Claim 30 is respectfully traversed. As the Examiner indicated in the above-referenced interview, the reason for the objection is that Claim 30, which is a method claim, cannot be dependent on an article claim, such as Claim 1. The Examiner indicated that

this objection could be overcome by amending Claim 30 into independent form, which has been done. As Applicants' attorney pointed out during the interview, the term "forming" is an acceptable process step.

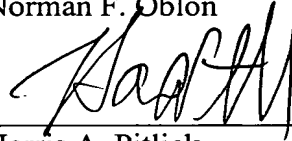
For all the above reasons, it is respectfully requested that the objection be withdrawn.

Applicants respectfully submit that all of the presently pending claims in this application are now in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Respectfully submitted,

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